

REMARKS

Reconsideration of the rejection contained in the Office Action of July 13, 2004 is respectfully requested.

All claims pending in the application, namely 13 to 24, stand rejected under anticipatory grounds. Claims 13, 15-17 and 20-23 also are rejected under the judicially created doctrine of obviousness-type double patenting. Applicants respectfully disagree.

DOUBLE PATENTING REJECTION

Claims 13, 15-17 and 20-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 8, 17, 19 and 20 of U.S. Patent Application Publication No. 2002/0089568 A1 (IGB 1539).

In addition, Claims 13, 15-17 and 20-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-5, 12, 16 and 17 of U.S. Patent Application Publication No. 2002/0097312 A1 (IGB 1540). Applicants respectfully disagree.

The claims in IGB 1539 are directed to a printing method comprising printing on a paper substrate coated on one surface with a pigment layer and a sealing layer and on the opposite surface with an adhesive.

The claims in IGB 1540 are directed to a printing method comprising printing on a polymeric substrate coated on one surface with a sealing layer and an ink receiving layer and on the opposite surface with an adhesive.

The now amended invention claims are patentably distinct from either of these published applications in providing a "single" ink receiving layer on either a paper or polymeric substrate in contrast to the multiple layers defined in the IGB 1539 and IGB 1540 claims.

Applicants further direct the Examiner's attention to the filing dates of the IGB 1539 and IGB 1540 applications which are both September 17, 2001. The pending application has a filing date of November 15, 2000, which is earlier than the published applications. Thus, even if the Examiner finds Applicants arguments unpersuasive, it is believed no terminal disclaimer would be necessary since the patent terms for the present application would expire earlier than the published applications.

Accordingly, Applicants believe the Examiners double patenting rejections have been overcome and should be withdrawn.

ANTICIPATORY CLAIM REJECTIONS - 35 U.S.C. §102(e)

Claims 13-24 stand rejected under 35 U.S.C. 102(e) as being anticipated by JP 11-30110 to Ashida et al (English translation). Applicant's respectfully disagree.

It is axiomatic that "[f]or a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference." *In re Bond*, 910 F.2d 831, 832, 15 USPQ 1566, 1567 (Fed. Cir. 1990).


As currently amended Claim 13 defines the receiving medium as a substrate coated with a **single** ink receiving layer comprising polymeric particles having film forming temperatures between 60 to 140 °C and a binder. See Applicant's specification at page 3 lines 14-18, and Examples 1, 2 and 3 for support for this amendment.

In contrast, the Ashida reference discloses a recording sheet comprised of multiple coating layers - an ink absorbing layer, a thermoplastic organic resin particle layer - on a waterproof base material. See Ashida paragraph 0013 and Claim 1.

As now amended Ashida does not contain every element of the present invention as embodied in independent Claim 13 and thus is not anticipatory of the claims. Accordingly, Applicants believe that these rejections have been overcome and should be withdrawn.

Accordingly, Applicants believe all rejections have been overcome and submit that this application is now in condition for allowance. Reconsideration of this application and allowance of pending claims 13-24 are hereby requested. No new matter has been introduced by this Amendment. If a telephone interview would be useful to advance this case, then the Examiner is invited to telephone the undersigned.

Respectfully submitted,
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